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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,230	11/28/2003	Saul Katz	45496.20	1229

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CANADA

EXAMINER

PRATT, HELEN F

ART UNIT	PAPER NUMBER
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1761

MAIL DATE	DELIVERY MODE
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06/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/707,230

Applicant(s)

KATZ ET AL.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 10, 11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbert (5,776,887).

Wilbert et al. disclose a composition containing the claimed ingredients as in claims 1, 10, 11 and 15. The carbohydrate content is seen to have been more than 50% as in claims 1, 10 and 11 because rolled oats, which are a complex carbohydrate with a low GI is used in predominant amounts and the reference discloses 62% carbohydrates (col. 8, lines 40-60.). Also, the GI is seen to have been within the claimed amounts of 1, 10, 11 and 15, due to the use of complex carbohydrates absent a showing to the contrary. Therefore, it would have been obvious to use known ingredients, and known amounts of COH and a GI absent a showing to the contrary.

Claims 1, 8, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid (6,458,378).

Sunvoid disclose a composition as in claim 1 for improving glucose metabolism in animals by controlling the insulin response, which contains a source of protein, fat, and carbohydrates (abstract). The carbohydrates in the food item are greater than 45% by weight. Grains are not considered to be rapidly absorbed carbohydrates, since they contain a lot of fiber, which keeps the carbohydrates from being rapidly absorbed (col. 8, lines 35-60). Claims 1 and 8, 10, 11 differ from the reference in the particular glycemic index (GI). Sunvoid discloses the use of a composition containing grains, which is seen to have produced a composition with a GI lower than 50 since grains are used in the composition and no simple sugars or sucrose. Therefore, it would have been obvious to make a composition using the claimed ingredients.

Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid as applied to the above claims, and further in view of Wilbert (6,458,378).

Claim 9 further requires that the composition contains inulin, but not a starch. However, Wilbert discloses that it is known to use inulin in a diet, which controls the GI (col. 3, lines 50-59). Therefore, it would have been obvious to use a known source of fiber in the composition of Sunvoid for its known function.

Claims 1, 10, 11, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nidetch (* Weight Watchers), pages 218, 219, Cheddar Muffins.

Nidetch disclose a composition containing protein, fat and carbohydrates where the total carbohydrate content is more than 45% as in claims 1 and 10. Casein is the major protein found in cheddar cheese and skim milk as in claim 14. The claims differ

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from the reference as to the particular GI. However, the GI is seen to have been less than 40 as in claims 1, 10, 11 and 14 and less than 35, as in claim 13 since the composition has been shown (pages 218, 219). Therefore, it would have been obvious to make a composition containing the claimed ingredients and glycemic index.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid in view of Wilbert, and further in view of Foster-Power International Table of Glycemic Index.

Claim 16 further requires that the composition is a food item with particular amounts of ingredients. However, it is seen that it would have been within the skill of the ordinary worker to determine the amounts of carbohydrate and the glycemic index of various foods and to make a composition with known ingredients which was within the claimed limitations especially as applicants have provided in their Information Disclosure Statement a table of Foods which shows the glycemic index of various foods. Attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper

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showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Also, Painter discloses the value of using the GI to determine which foods would have been desirable for people and that "an energy bar could be designed with COH's that provide a low glycemic response using fructose and that the GI can be accurately estimated from food (page 04, 1st col. 2nd paragraph, page 07, first para., col. 2.). Therefore, it would have been obvious to choose various foods with known amounts of carbohydrate and a known glycemic index in which to make a food composition.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 13-16 been renumbered claims 12-15. However, in the above office action the original claim numbering was maintained.

ARGUMENTS

Applicant's arguments filed 12-29-06 have been fully considered but they are not persuasive. Applicants have presented an affidavit to swear behind some of

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the references. The affidavit is persuasive and the cited references have been dropped.

Applicants argue as to the Wibert reference that the composition contains rapidly absorbed carbohydrates. However, the reference is now being used only to show that it is known to use inulin, which is not rapidly absorbed.


The further arguments are moot due to the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5-28-07 hp


HELEN PRATT
PRIMARY EXAMINER